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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,151	01/14/2004	Michael P. Casey	WMS-043	3165
30223	7590	02/07/2008		
NIXON PEABODY LLP 161 N. CLARK STREET 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER KIM, ANDREW	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 02/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/757,151	Applicant(s) CASEY ET AL.	
	Examiner Andrew Kim	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 24, 26-33, 36-43 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 24, 26-33, 36-43, 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to the amendment filed on 10/31/07 in which:

- Claim(s) 22,33,43 have/has been amended.
- Claim(s) 23,25,34,35,44,45 have/has been canceled.
- Response to claims rejection have been filed.
- Claim(s) 22, 24, 26-33, 36-43, 46-48 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 26-27, 29-33, 36-39, 41-43, and 47-48 rejected under 35 U.S.C. 102(b) as being anticipated by Gilmore et al. (US 6347996 B1).

Claims 22, 26, 27, 29, 31, 33, 37-39, 41, 43, 47, 43. Gilmore discloses a method of conducting a wagering game on a gaming machine controlled by a controller in response to a wager, the method comprising:

displaying on a display device of the gaming machine, an assemblage of selectable tiles that conceal an associated plurality of icons, the plurality of icons including a plurality of game-theme icons and a wild icon (Abstract, fig.5 and 6, col. 4:10-67) the game-theme

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icons have been interpreted as the cards/tiles that turn over and the associated award value;

receiving successive selections of the tiles (Abstract, fig.5 and 6, col. 4:10-67);

selectively revealing a first group of related game-theme icons associated with the selected tiles, the first group including at least two first tiles from the assemblage of selectable tiles, each of the first tiles having a first game-theme icon, the first game-theme icon from one of the first tiles matching the first game-theme icon from another one of the first tiles (Abstract, fig.5 and 6, col. 4:10-67);

selectively revealing a second group of related game-theme icons associated with the selected tiles, the second group being different from the first group, the second group including at least two second tiles from the assemblage of selectable tiles, each of the second tiles having a second game-theme icon, the second game-theme icon from one of the second tiles matching the second game-theme icon from another one of the second two tiles (Abstract, fig.5 and 6, col. 4:10-67);

selectively revealing the wild icon associated with the selected tiles after revealing the first group and the second group (Abstract, fig.5 and 6, col. 4:10-67); and

in response to revealing the wild icon, simultaneously awarding a first award and a second award, the first award being based on the at least two first tiles of the first group, the second award being based on the at least two second tiles of the second group (Abstract, fig.5 and 6, col. 4:10-67).

Claims 30, 36, 48. Gilmore discloses wherein the gaming machine comprises a video slot machine, and wherein displaying the assemblage of selectable tiles includes displaying a

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video generated assemblage of selectable tiles (Abstract, fig.5 and 6, col. 4:10-67).

Claim 32. Gilmore discloses wherein the first award comprises a first credit amount, and wherein the second award comprises a second credit amount (Abstract, fig.5 and 6, col. 4:10-67).

Claim 42. Gilmore discloses wherein the assemblage of selectable tiles is arranged as a matrix having multiple rows and columns (Abstract, fig.5 and 6, col. 4:10-67).

Claim 44. Gilmore discloses wherein the tiles associated with each award of the multiple award outcome are linked with a group of related icons and a wild icon (Abstract, fig.5 and 6, col. 4:10-67).

Claim 45. Gilmore discloses wherein the tiles associated with each award of the multiple award outcome are linked with a pair of like game-theme icons and a wild icon (Abstract, fig.5 and 6, col. 4:10-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 24, 28, 40 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore et al. (US 6347996 B1) in view of Schneider et al. (US 6,089,976).

Claims 24. Gilmore substantially discloses the invention as claimed but fails to explicitly teach displaying a legend adjacent to the assemblage of selectable tiles, the legend displaying a plurality of matches and respective awards, each of the plurality of matches including a plurality of related game-theme icons.. In an analogous reference, Schneider teaches having a pay table to provide the player with the winnings (Schneider, col. 3:19) and credit meter 42 (Schneider, col. 4:62). Schneider is an analogous reference because Schneider discloses displaying a plurality of selectable tiles that are selectively revealed to the player. One of ordinary skill in the art would have seen the benefit of adding a legend or payable to entice the player by showing the player how much the player may win with a single wager. The payable also functions as an easy-to-understand table that enables the player to translate what he sees on the display to possible money in his account thereby enticing the player to play the game more increase casino profits. Therefore, it would have

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been obvious to one of ordinary skill in the art at the time of the invention to add a legend or payable to entice the player to play the game and increase casino profits.

Claims 28, 40, 46. Gilmore substantially discloses the invention as claimed but fails to explicitly teach wherein the first award comprises a first number of free reel spins, and wherein the second award comprises a second number of free reel spins. However, it is well known and obvious in the art at the time of the invention to provide free spins as awards. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to modify the monetary award in Gilmore to the equivalent of free spins as the award to enhance player appeal and allow the player to have more chances to win a prize.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Kim whose telephone number is 571-272-1691. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AK 2/4/2008



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SUPERVISORY PATENT EXAMINER